



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,389	08/15/2003	Jay Fraleigh	040292.003	9489

25461 7590 10/21/2004

SMITH, GAMBRELL & RUSSELL, LLP
SUITE 3100, PROMENADE II
1230 PEACHTREE STREET, N.E.
ATLANTA, GA 30309-3592

EXAMINER

ALIMENTI, SUSAN C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,389

Applicant(s)

FRALEIGH ET AL.

Examiner

Susan C. Alimenti

Art Unit

3644

[Signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-21, 26-29, 31, 32 and 34 is/are rejected.
- 7) ☐ Claim(s) 12, 13, 30 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Declaration under 37 C.F.R. 1.132

1. The declaration under 37 CFR 1.132 filed 04 August 2004 is insufficient to overcome the rejection of claims 1-11, 14-18, 20 and 21 based upon 35 U.S.C. 103, Baird in view of Billings as set forth in the last Office action because: Bilderback and Fraleigh both generally discuss the fact that Baird discloses a covered bed comprising "bare-root plants", and allegedly would not be usable with a plant container because the water emitted from line 100 (Baird, Figure 4) would not reach the plant contained in the plant container. This is not a convincing argument since Baird teaches that line 100 maybe any "type of conduit for conducting water and liquid-born nutrients to the area within the ring" (Baird, col.5, lns.30-32). Therefore, Baird's line 100 could be a spray-type conduit emitting a flow sufficient to provide ample irrigation to a plant container disposed inside the ring.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 14-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baird (US 5,709,049), and further in view of Billings (US 6,223,466).

Baird discloses the claimed invention except the plant is not placed in a plant container before being inserted into the ground. Baird's ground cover method comprises creating a raised.

Art Unit: 3644

planting bed 46, covering the same with a water-permeable weed barrier 80, inserting a hole 88 into said barrier 80. Baird further teaches that his system can be utilized to surround various objects or plants other than those shown in the figures (Baird, col.6, lns.35-40). Billings discloses an alternate planting system comprising a double container setup that is embedded in a hole in the ground. Billings' system allows the user to easily interchange plant containers by removing container 12 from container 20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Billing's planting system with Baird's ground cover in order to allot the user the versatility to change the plants being displayed.

Regarding claim 2, Baird's system comprises an individual directed water line 100.

Regarding claims 3, 6, 14, the container 50 in Billings' device (Figure 1-2) is considered to be the root deterrent material wrapped about plant container 12.

Regarding claims 4-5, 9, the water line 100 is considered to serve the dual purpose of water supply and temperature control, since water is a known coolant and the introduction of such would affect the temperature of the plant bed 46. Furthermore Baird discloses the that the hose 100 may be in many different forms including but not limited to drip irrigation (Baird, col.5, lns.30-32)

Regarding claims 7, 15-17, 19, and 20, Baird's device is considered to have a spray emitting function since water line 100 is provided with holes 104, and the form of the water output is merely dependent on water pressure

Regarding claims 8, 18, and 21, Baird, as modified, disclosed water line 100 affixed to planting bed 46, which is considered to be a container holding the container plant therein.

Art Unit: 3644

4. Claims 11 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baird in view of Billings as applied to claim 10 above, and further in view of Nir et al. (US 4,437,263).

Baird, as modified, discloses the claimed invention except there is no temperature controlling line beneath the weed deterring material for controlling the bed temperature. Nir et al. (Nir hereafter) teaches the use of an underground heating system, comprising lines 21 that run just below the root system of plants and provide heated water to the ground surface. This upwelling of thermal energy controls the temperature of the ground surface and prevents cold damage to the root systems. Further, it is usable in any agricultural application. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Nir's system with Baird's system in order to prevent cold damage to root systems.

5. Claims 26-29, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 5,117,580) and further in view of Vogt (US 3,328,913).

Brown discloses the claimed invention except it is not positively disclosed that the plants 44 are disposed in a plant container. Browns' system comprises a raised bed 52, a weed barrier sheet 22 that is permeable to water through the holes in which plants 44 are disposed. Brown's system further comprises a temperature control line 24 beneath sheet 22 and further includes a drip tape 64 (Brown, Figure 7) that provide each plant an individual water line. It is noted that the transplanting of a tree, plant or flower in the ground while still in a plant container is well-known in the art, as it offers various advantages to the user. An example of this is provided in Vogt's plant container that is useful to promote healthy root growth early in the plant's life and

Art Unit: 3644

will later disintegrate in the ground. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown's system by using Vogt's plant container in order to further promote the growth of certain plants, thus providing an even more favorable environment for the plants.

Allowable Subject Matter

6. Claims 12-13, 30 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 04 August 2004 have been fully considered but they are not persuasive. The crux of applicant's arguments is that the combination of Baird and Billings is allegedly (1) not sufficiently taught by the references and (2) when combined they create a non-functional system. The Examiner respectfully disagrees with both points.

In response to the first argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is to improve Baird's device by replacing a permanent plant

Art Unit: 3644

with a removable pot, allowing for interchanging and transplanting of the desired plant. Such an option, as taught by Billings, provides versatility to the user. As seasons change annual flowers or plants must be replaced. Some flowers need to be removed from the outdoors yearly and placed in a greenhouse during the winter months or else they will not survive. In other cases landscapers may simply wish to replace the plants in order to satisfy the aesthetic requirements of certain occasions. One of ordinary skill in the art would find that Baird's device is clearly improved for the user when used in combination with Billings' removable pot.

In response to the second argument that when Baird's and Billings' devices are used in combination they produce a non-functional system the examiner respectfully disagrees. Applicant claims that because water would not permeate the sides of Billings' pot, the plant would not receive water. It is first noted that Baird, as discussed above, discloses that the irrigation system maybe any type known in the art. This clearly includes the well-known spray type irrigation hoses, which would emit a spray or stream clearly reaching the topsoil of Billings' pot providing water to the plant. Even if drip or soaker type irrigation hoses are instead used, Billings discloses a unique embodiment in Figure 11 that comprises holes 28 that allow water to permeate though the sides of the container (Billings, col.8, lns.15-34).

In conclusion, for these and the reasons listed in the rejections above, the examiner maintains the rejections of claims 1-11, 14-21.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3644

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCA

A handwritten signature in black ink, appearing to read "Teri P. Luu", is positioned above the printed name and title.

TERI P. LUU
SUPERVISORY PRIMARY EXAMINER